

OFFICE OF PETITIONS

PATENT



In re application of Curtis PRIEM et al.

Attorney Docket No. NVID001/00US

Serial No.:

09/056,656

Examiner:

Ulka Chauhan

Confirmation No.: 5595

Art Unit:

2671

Filed:

April 7, 1998

For:

TEXTURE CACHE FOR A COMPUTER GRAPHICS ACCELERATOR

U.S. Patent and Trademark Office 220 20th Street S. Customer Window, Mail Stop Petition Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

TRANSMITTAL OF RESPONSE

Enclosed are the following documents in response to the Decision on Petition mailed May 14, 2004 for the above-identified application:

- Renewed Petition Under 37 C.F.R. §1.182 including Exhibits 6-12; and [x]
- Return receipt postcard [x]
- to Deposit Account No. 50-1283 for the total fee. This paper Please charge \$ is being submitted in duplicate.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

Dated: July 14, 2004

Respectfully submitted, COOLEY GODWARD LLP

Cooley Godward LLP ATTN: Patent Group One Freedom Square Reston Town Center 11951 Freedom Drive Reston, VA 20190-5656

Tel: (703) 456-8000

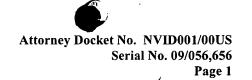
Reg. No. 48,174

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211903 v1/RE

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PATENT

Attorney Docket No: NVID001/00US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Priem et al.

Serial No.:

09/056,656

Examiner:

Ulka J. Chauhan

Filed:

April 7, 1998

Art Unit:

2676

For:

TEXTURE CACHE FOR A COMPUTER GRAPHICS ACCELERATOR

U.S. Patent and Trademark Office

2011 South Clark Place

Customer Window, Mail Stop Petition

Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

ATTN: Please Deliver to Paul Shanoski c/o Office of Petitions

RENEWED PETITION UNDER 37 CFR § 1.182

Petitioners filed a Petition under 37 C.F.R. §1.182 on December 30, 2003 requesting that a Declaration of facts under 37 C.F.R. §1.131 be accepted without the signature of one coinventor. The PTO DISMISSED the Petition under 37 C.F.R. § 182 on May 14, 2004. This renewed Petition under 37 C.F.R. § 1.182 provides supplemental documentary evidence and remarks in response to the deficiencies indicated in the PTO Decision, and authorizes use of a deposit account for any fees that may be required for acceptance and consideration of this renewed petition.

Petitioners hereby incorporate the evidence and remarks of the December 30, 2003 Petition by reference, including the last known address for non-signing inventor Curtis Priem.

SUPPLEMENTAL DOCUMENTARY EVIDENCE

- Exhibit 6 Letter from Steven R. Olsen to Fred B. Weil (Hanson Bridgett), copying Curtis Priem, dated June 25, 2004, and clearly identifying all enclosures related to U.S. Application No. 09/056,656.
- Exhibit 7 UPS Package Tracking printout showing that Exhibit 6 was received on June 29, 2004 by MARIANO.
- Exhibit 8 Letter from Richard J. Stratton (Hanson Bridgett) to Steven R. Olsen confirming receipt of Exhibit 6, and confirming that he informed Curtis Priem of the letter and enclosed application.
- Exhibit 9 UPS Package Tracking printout showing that UPS made 3 unsuccessful attempts at delivering Exhibit 6 to Curtis Priem before returning to shipper.
- Exhibit 10 Letter from Steven R. Olsen to Curtis Priem, dated July 10, 2004, clearly identifying all enclosures related to U.S. Application No. 09/056,656.
- Exhibit 11 UPS Tracking sheet showing that Exhibit 9 was received on July 12, 2004 by Curtis Priem.
- Exhibit 12 Declaration by Steven R. Olsen of Curtis Priem's oral refusal to join in prosecution of U.S. Application No. 09/056,656.

REMARKS

The PTO's May 14, 2004 Decision indicates that the December 30, 2003 Petition was DISMISSED due to a lack of proof that "a copy of the entire application (including specification, claims, drawings, and the oath or declaration)" was delivered to non-signing inventor Curtis Priem (PRIEM). Petitioners respectfully submit that evidence in the December 30, 2003 Petition was sufficient to show that PRIEM received all necessary documents. But even if the earlier evidence was lacking, new evidence presented in this renewed Petition proves that PRIEM has received a complete copy of the subject application and the Declaration under 37 C.F.R. 1.131, and that PRIEM maintains his refusal to join in prosecution of the subject application.

- I. Evidence in the December 30, 2003 Petition was Sufficient to Show that Priem

 Received all Necessary Documents
 - A. PRIEM was presented with a Declaration under 37 C.F.R. § 1.131

Petitioners submit that Exhibits 1– 4 of the December 30, 2004 Petition demonstrate that PRIEM, and his counsel, received a Declaration under 37 C.F.R. §1.131 for the subject application. For example, the second paragraph of Exhibit 1 states, in part "[t]he fourth matter (P000030) relates to a declaration that we would like you to execute in a pending application. The declaration would enable NVIDIA to swear behind a reference being asserted by the Examiner..." In addition, the list of enclosures for Exhibit 1 includes a "Declaration for Application No. P000030."

B. The Declaration was for Application No. 09/056,656

In dismissing the December 30, 2004 Petition, the Petitions Attorney expresses confusion over the association between Application No. 09/056,656, and docket numbers P000030, NV30, and NVID-001/00US.

In fact, P000030 is a docket number used by NVIDA's in-house patent counsel, NV30 is a docket number used by prior outside patent counsel, and NVID-001/00US is a docket number used by present outside patent counsel. Notwithstanding parallel docket number citations, Petitioner's December 30, 2004 Petition clearly lists Application No. 09/056,656 in the header, thereby associating Exhibits 1-5 with the same Application No. (and none of the other matters in Exhibit 1 relate to a 1.131 Declaration). Moreover, the signature of the registered patent attorney on the December 30, 2004 Petition represents a certification of truth in the association of Application No. 09/056,656 with P000030. 37 C.F.R. § 10.18; MPEP 402.

Petitioners respectfully submit that the evidence supports the fact that PRIEM was presented with a 37 C.F.R. § 1.131 Declaration for Application No. 09/056,656.

- C. No other application papers were required to be presented in this instance
 - i. Unlike execution of a Declaration under 37 C.F.R. § 1.63, execution of a Declaration under 37 C.F.R. § 1.131 does not require a copy of the application

MPEP 409.03(d) cites In re Cray, 115 USPQ 80 (Comm'r Pat. 1956) for the proposition that "[i]t is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is appraised of the application to which the oath or declaration is directed." Gray involved, *inter alia*, a dispute over an initial filing date under Rule 65.

The present matter is distinguishable from Gray. Here, Applicants are submitting a Declaration under 37 CFR §1.131(b), which merely requires "[t]he showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference." Because the form of Applicants' 37 C.F.R. § 1.131 Declaration expressly lists combinations of features and does not rely on any reference to the specification, drawings or claims for a description of the invention, there is no reason to provide a copy of the application to the non-signing inventor. Instead, the inventors were asked to make their declaration based on their recollection of when certain combinations of features (described in the Declaration) had been reduced to practice (their recollection being refreshed with Exhibits A and B to the Declaration).

Accordingly, Petitioners respectfully submit that there was no requirement to submit a copy of the specification, drawings, and claims to PRIEM.

ii. The requirement for presenting application papers is waived where, as here, there is a general refusal to cooperate by the non-signing inventor

The MPEP states that "[a] refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers." MPEP 409.03(d)(under the heading of Refusal to Join)(emphasis added). Support for such an exception is also found in Gray: "It is apparent, of course, that evidence of a proffer of the application should not be required where there is a general refusal by the inventor to receive or consider papers offered to him." Id.

The second paragraph of Exhibit 1 makes clear what is being requested of Priem. *See esp.* the second paragraph. Exhibit 5 to Applicants' 37 CFR 1.182 petition is a Declaration of attorney Thomas G. LaWer. Item 4 of that Declaration describes a conversation between LaWer and Fred B. Weil (PRIEM's attorney): "[i]n the course of that conversation, Mr. Weil indicated that cooperation from Mr. Priem on patent prosecution matters related to NVIDIA is contingent on the resolution of certain unrelated disputes between Mr. Priem and NVIDIA. Because the unrelated disputes are outstanding, Mr. Priem is refusing to provide any assistance in the patent prosecution matters." This is clear evidence of Mr. Priem's general refusal to cooperate.

Applicants respectfully submit that by communicating (through his attorney) a general refusal to cooperate, Mr. Priem has waived any right to be presented with any papers relating to the application.

5

II. New Evidence Presented in This Renewed Petition Proves That Priem Has Received a

Complete Copy of the Subject Application and the Declaration Under 37 C.F.R. § 1.131, and

that Priem Maintains His Refusal to Join in Prosecution of the Subject Application

A. PRIEM has now been presented with a complete copy of the Application

Newly submitted Exhibits 6-8 prove that a copy of the 09/056,656 Application (including

specification, claims, abstract, and drawings) and a 37 C.F.R. § 1.131 Declaration (including

Exhibits A and B) were presented to, and received by, the firm of Hanson Bridgett (PRIEM's

Counsel) on June 29, 2004. Exhibit 8 further establishes that notice of both the letter (Exhibit 6)

and the application were provided to PRIEM by PRIEM's counsel on July 9, 2004.

Newly submitted Exhibit 9 proves that unsuccessful attempts were made to deliver application

papers to PRIEM on June 29, June 30, and July 1, 2004. After PRIEM failed to pick-up the UPS

package, it was returned to sender.

Newly submitted Exhibits 10-12 prove that a copy of the 09/056,656 Application (including

specification, claims, abstract, and drawings) and a 37 C.F.R. § 1.131 Declaration (including

Exhibits A and B) were presented to, and received by, Curtis Priem on July 12, 2004.

B. PRIEM has reaffirmed his general refusal to cooperate in the prosecution of

the Application

Newly submitted Exhibit 12 proves that PRIEM has orally reaffirmed his general refusal to

cooperate in the prosecution of Application No. 09/056,656. Accordingly, with reference to the

citations in section I.C.ii above, Petitioners respectfully submit that there can be no defect in the

presentation of application papers to PRIEM in the subject matter.

6

CONCLUSION

Petitioners believe that all deficiencies noted in the PTO's May 14, 2004 Decision have been fully accommodated. Moreover, non-signing inventor Priem has indicated, through his attorney, and personally, that he has no intention to cooperate in the prosecution of the subject application. Accordingly, Petitioners request that this renewed petition for acceptance of the Declaration of facts under 37 C.F.R. 1.131 be GRANTED.

The Director is authorized to charge any shortage of fees that may be required under 37 C.F.R. §§ 1.16, 1.17, and 1.21 to Deposit Account 50-1283.

Dated: 7/14/04

Cooley Godward LLP

Attn: Patent Group
One Freedom Square - Reston Town Center

11951 Freedom Drive Reston, VA 20190-5656 Tel: (703) 456-8000

Fax: (703) 456-8100

SRO: Enclosures

211951 v1/RE 4JJJ01!.DOC Respectfully submitted, COOLEY GODWARD LLP

Steven R. Olsen Reg. No. 48,174

Cooley Godward LLP

June 25, 2004 VIA OVERNIGHT COURIER

Fred B. Weil, Esq. Hanson Bridgett Marcus Vlahos Rudy, LLP 333 Market Street, 23rd Floor San Francisco, CA 94105-2173

Re: **CURTIS PRIEM'S REVIEW OF.** DOCUMENTS RELATED TO U.S.

PATENT APPLICATION NO. 09/056,656

(NVIDIA Ref. P000030)

ATTORNEYS AT LAW

One Maritime Plaza 20th Floor San Francisco, CA 94111-3580 Main 415 693-2000 Fax

415 951-3699

www.cooley.com

STEVEN R. OLSEN 703-456-8062 solsen@cooley.com

JUL 1 5 2004

EXHIBIT 6

Broomfield, CO 720 566-4000 Palo Alto, CA

650 843-5000

703 456-8000

San Diego, CA 858 550-6000

Reston, VA

Dear Mr. Weil:

We are contacting you in your representation of Curtis Priem, on behalf of our client NVIDIA Corporation (NVIDIA). You may recall previous correspondence related to the same parties and matter with Mr. Richard Domingo (of NVIDIA) and Mr. Thomas G. LaWer (formerly of our firm).

NVIDIA continues to seek Mr. Priem's cooperation for the continued prosecution of the subject pending patent application, which is entitled TEXTURE CACHE FOR A COMPUTER GRAPHICS ACCELERATOR. Toward that end, we have enclosed the following documents for Mr. Priem's prompt review and action:

- a copy of U.S. Patent Application No. 09/056,656, as-amended. The document includes 21 pages of specification before the claims, the specification reflecting the originally filed text and any amendments made thereto during the time the application has been pending at the U.S. PTO. There are 2 pages of claims that reflect all of the claims which are presently pending in the application (including claims 100, 104-108, and 111). There is a 1 page Abstract, and there are 5 sheets of drawings (including Figures 1-6);
- a DECLARATION UNDER 37 CFR § 1.131 BY CURTIS PRIEM, GOPAL SOLANKI, AND DAVID KIRK IN SUPPORT OF ANTEDATING REFERENCE (DECLARATION);
- Exhibit A to the DECLARATION; and
- Exhibit B to the DECLARATION.

In particular, we ask that Mr. Priem review and sign the enclosed DECLARATION. The DECLARATION states facts concerning the invention that is the subject matter of the pending claims. More specifically, the DECLARATION advises the U.S. PTO that the claimed invention

Cooley Godward LLP

Fred B. Weil, Esq. June 25, 2004 Page Two

came into being some time prior to a reference cited by the Examiner. If there are any errors in the DECLARATION, we ask Mr. Priem to specifically identify any such errors so that they may be corrected. If Mr. Priem refuses to review the above documents, then we ask for confirmation of his continued general refusal to cooperate in this matter.

Time is of the essence. Accordingly, we ask for a response to this letter as soon as possible, <u>but</u> <u>not later than July 9, 2004</u>. For your convenience, we have enclosed a self-addressed OVERNIGHT COURIER package to expedite your response.

Your attention to this matter is appreciated.

Sincerely,

STEVEN R. OLSEN

cc: Mr. Curtis Priem, 4052 Kettering Terrace, Fremont, CA 94536 (with enclosures)

210062 v1/RE 4\$3201!.DOC

Re

Forgot Password

EXHIBIT 7





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Tracking

- → Track by Tracking Number
- → Track by Reference Number
- → Import Tracking Numbers ≜
- → Track by E-mail
- → Get Quantum View Files 🇎
- → Request Quantum View Notify
- 🗦 Void a Shipment 🕯
- → Help.



Track by Tracking Number

View Details

Log-In User ID:

Status: Delivered on: Delivered

Jun 29, 2004 10:22 A.M.

Password:

Signed by: MARIANO Location: RECEPTION

SAN FRANCISCO, CA, US

Delivered to: Shipped or Billed on: Jun 28, 2004

Tracking Number: Service Type:

1Z E44 2W5 25 4074 183 3

NEXT DAY AIR

Packag	ge Pro	gress:
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Date	Time	Location	Activity
Jun 29, 2004	10:22 A.M.	SAN FRANCISCO, CA, US	DELIVERY
	8:44 A.M.	SAN FRANCISCO, CA, US	OUT FOR DELIVERY
	7:30 A.M.	SAN FRANCISCO, CA, US	OUT FOR DELIVERY
	7:15 A.M.	SAN FRANCISCO, CA, US	ARRIVAL SCAN
	6:18 A.M.	OAKLAND, CA, US	DEPARTURE SCAN
	4:54 A.M.	OAKLAND, CA, US	ARRIVAL SCAN
	3:45 A.M.	LOUISVILLE, KY, US	DEPARTURE SCAN
	12:21 A.M.	LOUISVILLE, KY, US	ARRIVAL SCAN
Jun 28, 2004	10:45 P.M.	CHANTILLY, VA, US	DEPARTURE SCAN
,	9:57 P.M.	CHANTILLY, VA, US	ARRIVAL SCAN
	9:43 P.M.	CHANTILLY, VA, US	DEPARTURE SCAN
	9:05 P.M.	CHANTILLY, VA, US	ORIGIN SCAN
	7:58 P.M.	US	BILLING INFORMATION RECEI'
	7:55 P.M.	CHANTILLY, VA, US	PICKUP SCAN

Tracking results provided by UPS: Jun 30, 2004 11:08 A.M. Eastern Time (USA)

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RICHARD J. STRATTON
PARTNER
DIRECT DIAL 415 995 5002
REPLY TO SAN FRANCISCO
E-MAIL rstratton@hansonbridgett com

EXHIBIT 8

HANSON BRIDGETT MARCUS VLAHOS RHOY-HP

July 12, 2004

VIA FACSIMILE (703) 456-8100 AND REGULAR MAIL

Steven R. Olsen, Esq. Cooley Godward, LLP One Freedom Square, 16th Fl. Reston, VA 20190-5656

Re.

U.S. Patent Application No. 09/056, 656 (NVIDIA Ref. P000030)

File No. 23247.1

Dear Mr. Olsen:

This will confirm our conversations over the last couple of weeks in regard to the above patent application. I responded to your June 25, 2004 letter because my partner Fred Weil was out of the country and our client Curtis Priem was similarly on vacation. Mr. Weil is still on vacation.

On July 9, I was able to speak with Mr. Priem and informed him that I had received your letter and the enclosed application. He has requested that NVIDIA send no more patent applications to our attention but send them direct to him. Our firm is not authorized to deal with patent applications on which the company may seek assistance. Mr. Weil and our firm continue to be involved, however, in any further discussions regarding the winding up of Mr. Priem's relationship with NVIDIA.

Pursuant to your instructions, I will destroy the patent application which was enclosed

with your letter.

Richard J. Strattor

RJS:amf

cc: Mr. Curtis Priem

LAW OFFICES
WWW.HANSONBRIDGETT.COM

SAN FRANCISCO

333 MAKKET STREET 23RD FLOOR SAN FRANCISCO - CALIFOANIA Y4105-2173 TELEPHONE 415 777-3200 FACSIMILE 415 541 Y366

SF@HANSONBRIDGETT.COM

NORTH BAT

WOOD ISLAND

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LAKKSPUR - CALIFORNIA 94939

1ELEPHONE 413 723 BADU
FACSIMILE 413-925-84U7

NOKIHBAT@HANSONBKIDGETT COM

SACRAMENTO

TESTRE MTNIN 089

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LECE-SPE 614 SHOHYSIST

BREE SPE 414 SHORSON

BREE SPE 414 SHORSON

SAC@HANSONBHDGETT COM

1116052.1

http://wwwapps.ups.com/WebTracking/processRequest

UPS Package Tracking

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Tracking

Log-In User ID:

Password:

Register

S | Forgot Password

→ Track by Tracking

- → Track by Reference Number Number
- → Import Tracking Numbers #
- → Get Quantum View → Track by E-mail Files 🔒
- → Request Quantum
- View Notify

 ◆ Void a Shipment

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→ Help

Better transportal Better visibility. Better control. network

Management Network

Find Answers to **Your Tracking** Questions

→ Go to Tracking Number

IIIII Track by Tracking Number

View Details

Jul 12, 2004 9:55 A.M. Returned to Shipper MORER Delivered on: Signed by: Status:

MAIL ROOM

RESTON, VA, US Jun 28, 2004 Shipped or Billed on: Delivered to: Location:

1Z E44 2W5 A2 4016 180 4 NEXT DAY AIR **Tracking Number:** Service Type:

Package Progress:

Date/ Time	Location	Activity
Jul 12, 2004		-
9:55 A.M.	CHANTILLY, VA, US	DELIVERY
5:46 A.M.	CHANTILLY, VA, US	OUT FOR DELIVE
4:48 A.M.	CHANTILLY, VA, US	ARRIVAL SCAN
 3:48 A.M.	LAUREL, MD, US	DEPARTURE SCA
12:01 A.M.	LAUREL, MD, US	ARRIVAL SCAN
Jul 11, 2004		
7:45 P.M.	NEWARK, NJ, US	DEPARTURE SCA
6:30 P.M.	NEWARK, NJ, US	ARRIVAL SCAN
4:37 P.M.	LOUISVILLE, KY, US	DEPARTURE SCA
Jul 10, 2004		
2:23 A.M.	LOUISVILLE, KY, US	ARRIVAL SCAN
Jul 9, 2004		

OR DELIVERY **TURE SCAN**

TURE SCAN TURE SCAN 7/14/2004

RECEIVER WAS UNAVAILABLE TO SIGN ON 3RD DELIVERY

DEPARTURE SCAN

ARRIVAL SCAN

SAN JOSE, CA, US SAN JOSE, CA, US SAN JOSE, CA, US SUNNYVALE, CA, US SUNNYVALE, CA, US

7:21 P.M. 6:12 P.M. 6:08 P.M. 2:15 P.M.

7:22 P.M.

DEPARTURE SCAN DEPARTURE SCAN

EXHIBIT 9

ATTEMPT;RETURNED TO THE SENDER. THE PACKAGE WAS NOT PICKED UP AS ARRANGED	RECEIVER WAS UNAVAILABLE TO SIGN ON 3RD DELIVERY ATTEMPT;A POSTCARD HAS BEEN SENT TO THE RECIPIENT REQUESTING THAT THEY CONTACT LIPS	RECEIVER WAS UNAVAILABLE TO SIGN ON 3RD DELIVERY ATTEMPT	THE RECEIVER WAS NOT AVAILABLE TO SIGN ON THE 2ND DELIVERY ATTEMPT. A 3RD DELIVERY ATTEMPT WILL BE MADE	THE RECEIVER WAS UNAVAILABLE TO SIGN ON THE 1ST DELIVERY ATTEMPT. A 2ND DELIVERY ATTEMPT WILL BE MADE	ARRIVAL SCAN DEPARTURE SCAN	ARRIVAL SCAN DEPARTURE SCAN ARRIVAL SCAN	DEPARTURE SCAN ARRIVAL SCAN	DEPARTURE SCAN ORIGIN SCAN	BILLING INFORMALION RECEIVED PICKUP SCAN
	SUNNYVALE, CA, US	SUNNYVALE, CA, US	SUNNYVALE, CA, US	SUNNYVALE, CA, US	SUNNYVALE, CA, US OAKLAND, CA, US	OAKLAND, CA, US LOUISVILLE, KY, US LOUISVILLE, KY, US	CHANTILLY, VA, US CHANTILLY, VA, US	CHANTILLY, VA, US CHANTILLY, VA, US	CHANTILLY, VA, US
1 Jul	10:44 P.M.	10:22 A.M.	10:26 A.M.	Jun 29, 2004 10:27 A.M.	6:30 A.M. 5:46 A.M.	4:54 A.M. 3:45 A.M. 12:21 A.M.	Juli 26, 2004 10:45 P.M. 9:57 P.M.	9:43 P.M. 9:05 P.M. 7:59 P.M.	7:55 P.M.

Tracking results provided by UPS: Jul 14, 2004 4:36 P.M. Eastern Time (USA)

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7/14/2004

7/14/2004

UPS Package Tracking

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July 10, 2004

VIA OVERNIGHT COURIER

Mr. Curtis Priem 4052 Kettering Terrace Fremont, CA 94536 ATTORNEYS AT LAW

One Maritime Plaza 20th Floor San Francisco, CA 94111-3580 Main 415 693-2000

Fax 415 951-3699 www.cooley.com

STEVEN R. OLSEN 703-456-8062 solsen@cooley.com

Broomfield, CO 720 566-4000 Palo Alto, CA 650 843-5000 Reston, VA 703 456-8000 San Diego, CA

858 550-6000

EXHIBIT 10

Re: REVIEW OF DOCUMENTS RELATED TO

U.S. PATENT APPLICATION NO. 09/056,656 (NVIDIA Ref. P000030)

Dear Mr. Priem:

We are contacting you on behalf of our client NVIDIA Corporation (NVIDIA). You may recall previous correspondence related to the same matter with Mr. Richard Domingo (of NVIDIA).

NVIDIA continues to seek your cooperation for the continued prosecution of the subject pending patent application, which is entitled TEXTURE CACHE FOR A COMPUTER GRAPHICS ACCELERATOR. Toward that end, we have enclosed the following documents for your prompt review and action:

- a copy of U.S. Patent Application No. 09/056,656, as-amended. The document includes 21 pages of specification before the claims, the specification reflecting the originally filed text and any amendments made thereto during the time the application has been pending at the U.S. PTO. There are 2 pages of claims that reflect all of the claims which are presently pending in the application (including claims 100, 104-108, and 111). There is a 1 page Abstract, and there are 5 sheets of drawings (including Figures 1-6);
- a DECLARATION UNDER 37 CFR § 1.131 BY CURTIS PRIEM, GOPAL SOLANKI, AND DAVID KIRK IN SUPPORT OF ANTEDATING REFERENCE (DECLARATION);
- Exhibit A to the DECLARATION; and
- Exhibit B to the DECLARATION.

In particular, we ask that you review and sign the enclosed DECLARATION. The DECLARATION states facts concerning the invention that is the subject matter of the pending claims. More specifically, the DECLARATION advises the U.S. PTO that the claimed invention came into being some time prior to a reference cited by the Examiner. If there are any errors in the DECLARATION, we ask you to specifically identify any such errors so that they may be corrected.

Fred B. Weil, Esq. July 10, 2004 Page Two

Because you have apparently been out of the country, time is of the essence. Accordingly, we ask for a response to this letter not later than <u>July 13, 2004</u>. We have enclosed a self-addressed next day package for your convenience. You may also reply via facsimile.

Your urgent attention to this matter is appreciated.

Sincerely,

STEVEN R. OLSEN

210062 v2/RE 4\$3202!.DOC

Re





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Tracking

- → Track by Tracking Number
- → Track by Reference
 Number
- → Import Tracking Numbers ≜
- → Track by E-mail
- → Get Quantum View Files ≜
- → Request Quantum View Notify a
- → Void a Shipment #
- → Help



Find Answers to Your Tracking Questions

→ Go to Tracking Number FAQ

Track by Tracking Number

View Details

Log-In User ID:

EXHIBIT 11

| Forgot Password

Status: Delivered

Delivered on: Jul 12, 2004 10:24 A.M.

Signed by: PREIM
Location: RESIDENTIAL
Delivered to: FREMONT, CA, US
Shipped or Billed on: Jul 12, 2004

Tracking Number: 1
Service Type: N

1Z E44 2W5 A2 4021 517 6

Password:

NEXT DAY AIR

Package Progress:

Date/ Time	Location	Activity
Jul 12, 2004		
12:32 P.M.	US	BILLING INFORMATION RECEIVED
10:24 A.M.	SUNNYVALE, CA, US	DELIVERY
7:30 A.M.	SUNNYVALE, CA, US	OUT FOR DELIVERY
4:10 A.M.	SUNNYVALE, CA, US	ARRIVAL SCAN
3:06 A.M.	OAKLAND, CA, US	DEPARTURE SCAN
Jul 11, 2004		
6:50 P.M.	OAKLAND, CA, US	ARRIVAL SCAN
5:30 P.M.	COMMERCE CITY, CO, US	DEPARTURE SCAN
4:21 P.M.	COMMERCE CITY, CO, US	ARRIVAL SCAN
3:54 P.M.	LOUISVILLE, KY, US	DEPARTURE SCAN
10:19 A.M.	LOUISVILLE, KY, US	ARRIVAL SCAN
Jul 10, 2004		
9:34 P.M.	ALEXANDRIA, VA, US	DEPARTURE SCAN
7:16 P.M.	ALEXANDRIA, VA, US	ORIGIN SCAN
6:24 P.M.	CHANTILLY, VA, US	DEPARTURE SCAN
5:40 P.M.	CHANTILLY, VA, US	ORIGIN SCAN
3:06 P.M.	CHANTILLY, VA, US	PICKUP SCAN

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Attorney Docket No: NVID001/00US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Priem et

Serial No.:

09/056,656

Examiner:

Ulka J. Chauhan

Filed:

April 7, 1998

Art Unit:

2671

For:

TEXTURE CACHE FOR A COMPUTER GRAPHICS ACCELERATOR

U.S. Patent and Trademark Office 2011 South Clark Place Customer Window Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

EXHIBIT 12

DECLARATION BY STEVEN R. OLSEN IN SUPPORT OF RENEWED PETITION

- 1. I am an attorney, licensed to practice in the Commonwealth of Virginia and registered to practice before the U.S. Patent Office. I am an Associate at Cooley Godward, LLP, and our firm represents NVIDIA Corporation (hereinafter "NVIDIA") in various patent matters, including the prosecution of Application No. 09/056,656.
- 2. On Monday, July 12, 2004, at approximately 8:00 P.M. eastern time (5:00 p.m. pacific) I had a brief telephone conversation with Curtis Priem (PRIEM) regarding prosecution of Application No. 09/056,656.
- 3. During that conversation, PRIEM confirmed receipt of my letter dated July 10, 2004, but expressed a clear refusal to join in the prosecution of Application No. 09/056,656 or any other NVIDIA patent application. His reason for refusing to cooperate involves certain unrelated disputes with NVIDIA.

4. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Execution Date:

Steven R. Olsen 4

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